

## **REMARKS**

Reconsideration of this application is respectfully requested.

Claims 1-14 remain in the application.

Claim 14 was rejected under 35 USC 102(e) as being anticipated by Gacek (US Patent No. 6,795,205 B1) for the reasons set forth on pages 2-5 of the Office Action dated February 21, 2008. Claims 1-5, 8-10 and 12 were rejected under 35 USC 103(a) as being unpatentable over Gacek in combination with Lewis et al. (US Patent 6,233,565 B1) as set forth on pages 5-20 of the Office Action. Claims 6, 11 and 13 were rejected under 35 USC 103(a) as being unpatentable over Gacek with Lewis as applied to claim 1, and further in view of Lewis as set forth on pages 20-22 of the Office Action. Claim 7 was rejected under 35 USC 103(a) as being unpatentable over Gacek and Lewis as applied to claim 1, and further in view of Tezuka et al. (US 6,018,769) as set forth on pages 23-24 of the Office Action.

Gacek is directed to a system for authorizing the transmission of print data generated by a third-party application over a network to a home access device for printing on a printer connected to the home access device. Gacek discloses a system and method for allowing a home user to regulate the type and amount of print jobs that are push-printed, i.e., initiated by a third party other than the home user, to the home user from third-party internet applications, such as third-party merchants 102 and 103. The home user of Gacek provides preferences regarding the push-print service by identifying the third parties from which push-print jobs will always be allowed by the home user for printing on a printer of the home user and the home user provides information regarding the types of third parties from which push-print jobs will be allowed upon prior authorization from an

intermediary service. The authorization is obtained from the intermediary service for the internet application, e.g., third party merchants, to transmit the print data only if a payment is first negotiated to the intermediary service from the internet application. The payment preferably is transferred from the intermediary service to the user of the home access device to compensate the user for the ink and paper that are consumed when printing the print data on the home user's printer, thereby offsetting the expenses related to the printer-related consumables expended during the printing.

Lewis is directed is a system and method for conducting Internet based financial transactions between a client and a server. A transaction module is included. The client issues a transaction request to the server in response to the client and server being authenticated. The transaction server executes an electronic payment transaction at the server and records the transaction in the transaction database in response to a client transaction request. A server receipt generation module generates a receipt in response to an executed electronic payment and transmits the receipt to the client. The receipt includes the client digital signature and a data set uniquely identifying the executed transaction and is printable by the client printer. The printed receipt is evidence of payment for the executed transaction.

According to the invention of claim 1 of the present application, when a command requesting transmission of print data is sent from the image forming apparatus to the document server, and a print data recipient is a payer, the document server sends print data and accounting data designating the print data recipient as a payer to the image forming apparatus. When it is judged that the print data provider is a payer, the document server sends print data and accounting data designating the print data provider as a payer

to the image forming apparatus. The image forming apparatus collects the fee from the print data recipient when the image forming apparatus receives the accounting data designating the print data recipient as a payer from the document server.

On the other hand, Gacek merely discloses a system related to a process of performing data transmission to a user who is permitted to receive data, i.e., a user that allows print data initiated by a third party to be pushed to the user. In the system of Gacek, a user receives third party initiated print data as opposed to print data in response to a request from the user. Gacek does not disclose an image forming apparatus including “an accepting unit that accepts input of a document ID” and “a sending unit that sends the document ID inputted into the accepting unit to the document server” and the document server including “a payer judging unit that judges a payer of the fee relating to printout of the print data, based in the document ID”. In this manner, the system of amended claim 1 judges which of the print data recipient and the print data provider is a payer and charges the fee based on the result, i.e., collecting fees at the image forming apparatus if the print data recipient is a payer.

Furthermore, Lewis does not cure the deficiencies of Gacek. The Lewis reference merely discloses a technology of a charging processing, and it does not disclose a fee collecting processing performed in accordance with a payer as set forth in claim 1. Lewis discloses a transaction module wherein, in response to the client and server being authenticated, the client issues a transaction request to the server and the transaction server, in response to a client transaction request, executes an electronic payment transaction at the server and records the transaction in the transaction database. The server receipt generation module, in response to an executed electronic payment, then

generates a receipt and transmits the receipt to the client. Lewis does not disclose or suggest a document server including “a controlling unit that controls the data sending unit to send, to the receiving unit of the image forming apparatus, *the print data and the accounting data indicating that a print data recipient is the payer, if the payer judging unit judges that the print data recipient is the payer, and* that controls the data sending unit to send, to the receiving unit of the image forming apparatus, *the print data and the accounting data indicating that a print data provider is the payer, if the payer judging unit judges that the print data provider is the payer*” (emphasis added). Therefore, it is respectfully submitted claim 1 is not rendered obvious by Gacek and Lewis alone or in any combination, and is in condition for allowance. Claims 2-7 all depend, either directly or indirectly, from claim 1 and are patentable for at least the reasons set forth above in regards to claim 1.

Similarly, claim 8 is directed to “[a] document server which is so configured as to receive print data from a contents server providing various information including the print data, and to send the print data to an image forming apparatus which is installed remotely away from the document server but is communicatively connected therewith via the Internet, the document server comprising: a print data storing unit that stores print data sent from the contents server, and a document ID in association with the print data; a print data retrieving unit that retrieves, from the print data storing unit, the print data in association with the document ID sent from the image forming apparatus; a accounting unit that calculates a fee relating to printout of the print data retrieved by the print data retrieving unit, and stores the fee as accounting data; *a payer judging unit that judges a payer of the fee relating to printout of the print data, based on the document ID*; a data

sending unit that sends the print data and the accounting data to the image forming apparatus; and a controlling unit that controls the data sending unit to send, to the image forming apparatus, *the print data and the accounting data indicating that a print data recipient is the payer, if the payer judging unit judges that the print data recipient is the payer, and that controls the data sending unit to send, to the image forming apparatus, the print data and the accounting data indicating that a print data provider is the payer, if the payer judging unit judges that the print data provider is the payer*" (emphasis added). For at least the reasons put forth for claim 1, it is respectfully submitted claim 8 is not rendered obvious by Gacek and Lewis alone or in any combination, and is in condition for allowance. Claims 9-13 all depend, either directly or indirectly, from claim 8 and are patentable for at least the reasons set forth above in regards to claim 8.

Claims 3 and 10 recited "wherein at least one of the document server and the contents server further comprises print data altering unit that alters contents of the print data to be sent to the image forming apparatus depending on the client data". In contrast, the portion of Gacek pointed out by the Examiner relates to whether or not the print job is accepted by the home user. The print job of Gacek is accepted based upon preferences of the home user stored in preferences directory 21 or upon direction of the intermediary server. In neither case are the contents of the print data altered based on the client data of each user. Therefore in addition to the reason put forth for independent claims 1 and 8, claims 3 and 10 are not rendered obvious by the combination of Gacek and Lewis.

According to the invention of claim 4 and 11, the document server restricts the number of transmissions of the print data identified by the document ID received from the image forming apparatus. In column 4, lines 10-31 of Gacek recited by the Examiner, a

method is generally described for the authorized transmission of print data. No where in the cited passage or anywhere else in Gacek is it described that the number of transmissions of print data is restricted, let alone restricted based on the document ID. Therefore, in addition to the reason put forth for independent claims 1 and 8, claims 4 and 11 are not rendered obvious over the combination of Gacek and Lewis.

According to the invention of claim 6 and 13, the document ID is erased upon lapse of a predetermined period from the time when the document ID is received from the contents server. On the other hand, the part of the Lewis reference pointed out by the Examiner discloses that an old certificate for authenticity is deleted and replaced with a new certificate. The invention of claims 6 and 13 and the invention of Lewis are only similar in view of deletion of data. However, according to the invention of claim 6, the document ID is erased upon lapse of a predetermined period from the time when the document ID is received from the contents server so that a period for printing out the print data associated with the document ID can be restricted. The document ID of claims 6 and 13 is related to the print data whereas the certificate of Lewis is used for authenticating a user via the use of public and private keys. Therefore, in addition to the reason put forth for independent claims 1 and 8, claims 6 and 13 are not rendered obvious over the combination of Gacek and Lewis.

Claim 14 was rejected under 35 USC 102(e) as being anticipated by Gacek. Claim 14 is directed to an image forming apparatus including, inter alia, "an inputting unit that allows a user to input a document ID used in verifying that receiving of print data is permitted; a sending unit that sends the document ID inputted to the inputting unit to the server; a receiving unit that receives print data identified by the document ID sent from the

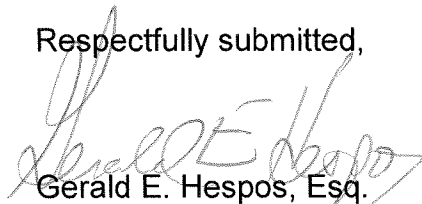
sending unit, and accounting data including information relating to a payer which is determined based on the document ID; an outputting unit that outputs the print data received by the receiving unit; and a fee collecting unit that collects a certain fee from a print data recipient if the print data recipient is determined as the payer based on the accounting data received by the receiving unit”.

The invention of claim 14 is directed to an image forming apparatus, according to which the image forming apparatus sends a command of requesting transmission of print data to the document server, and the image forming apparatus collects fees from a print data recipient when the image forming apparatus receives the accounting data designating the print data recipient as a payer. On the other hand, similar to the reason put forth above in relation to claims 1 and 8, the Gacek reference merely discloses a process of sending data to a user having a permission to receive data. Gacek does not perform collection of fees in accordance with whether the print data recipient is a payer, i.e., collection of fees performed when the print data recipient is a payer. Furthermore, the image forming apparatus of claim 14 includes an inputting section that allows a user to input a document ID which identified the print data requested, i.e., user initiated. The end user in Gacek requests a print job initiated by a third party without a need for an inputting section since the user of Gacek does not enter a document ID nor requesting specific print data. Therefore, it is respectfully submitted claim 14 is patentably distinct over Gacek and is in condition for allowance.

In view of the preceding remarks, it is submitted that the claims remaining in the application are directed to patentable subject matter and allowance is solicited. The

Examiner is urged to contact applicants' attorney at the number below to expedite the prosecution of this application.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Gerald E. Hespos", written in dark ink.

Gerald E. Hespos, Esq.

Atty. Reg. No. 30,066

Customer No. 001218

CASELLA & HESPOS LLP

274 Madison Avenue - Suite 1703

New York, NY 10016

Tel. (212) 725-2450

Fax (212) 725-2452

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